

### **Remarks**

Reconsideration and allowance in view of the comments which follow are respectfully requested.

Claims 1-23 were pending. No claims are being amended. Claims 1-23 are still now pending.

In the Office Action dated March 16, 2006, the Examiner rejected claims 1-3 and 21 as allegedly anticipated by Rosenberg U.S. Patent No. D 389,425. The Examiner also rejected claims 4-20 and 22-23 as being allegedly obvious over the Rosenberg combined with the Octo-Square Brilliant reference.

In the rejection of claim 1, the Examiner stated that, referring to Figs 5 and 8 of Rosenberg, the corner length is less than the length of the two sides of the stone. However, claim 1 recites that “each crown side and corner having a length along the girdle, said corner length being substantially less than said side length.” This claim language should be construed to mean that each corner (of the four corners) is less than the side length (of each of the four sides). In Rosenberg two of the sides are about the same length as the corners. Accordingly, claim 1 as properly construed is not anticipated by Rosenberg.

Claim 1 also recites at the end that each rib line extends in a substantially straight line when viewed from the bottom of the pavilion. In the Rosenberg reference in Figure 8, the lines that extend from the girdle to the culet which define the corners and sides of the pavilion are not all in a substantially straight line. In the Rosenberg reference, the lines that define the short and long sides, and thus the adjacent corners, have a substantial bend of about 25 degrees. The presence of this substantial bend means that not all of the rib lines in Rosenberg form a substantially straight line, as recited in claim 1.

The Rosenberg reference also does not disclose four pavilion sides and four pavilion sides defined by eight rib lines extending from the girdle to the centrally located culet at the bottom of the pavilion. In Fig. 8 of Rosenbeg, eight line segments reach the bottom culet, but two of those eight bisect the sides, and thus do not define the sides and corners. This leaves only six line segments which reach the culet. Claim 1 recites eight rib lines from the girdle to the culet. This feature is not disclosed in Rosenberg.

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Claim 3 recites the same relationship of the corner length being substantially less than the side length of all of the sides as in claim 1, a feature not disclosed in Rosenberg. Claim 3 also recites eight rib lines from the girdle to the culet to define the pavilion sides and corners, which is not disclosed in Rosenberg, as discussed above. Claim 3 also recites that each rib line extends in a substantially straight line, which is also not disclosed in Rosenberg. Claim 21 recites the same three features as in claims 1 and 3.

In view of the foregoing differences recited in claims 1, 3, and 21, these claims distinguish over Rosenberg.

Independent claims 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 22, and 23 have been rejected as allegedly obvious over Rosenberg combined with Octo-Square Brilliant.

Applicant submits that it would not have been obvious to combine these two references, because the gemstones of these respective references have each acquired a different status in the art, and one would not be motivated to pick and choose features from one and combine those features with the other.

The Rosenberg reference relates to an irregular eight sided gemstone having two long sides, two short ends and four corners about the same length as the two short ends, and much shorter than the long sides. The outline is an elongated eight sided stone. The pavilion sides and corners have many facets.

In contrast the Octo-Square Brilliant is a cut-cornered square stone having three unequal steps in the crown. In the crown sides, the largest step is in the middle and the smallest step is at the top. In the crown corners the largest step is at the top. Thus, the crown is characteristically unequal in step heights and symmetry for the crown sides and corners, at the bottom having four long sides and four short corners, while at the top of the crown the table has eight substantially equal sides, completely unlike the characteristic equal height steps in Rosenberg, wherein the table at the top has the same shape as the girdle.

The pavilion in Octo-Square Brilliant has simple single facet corners and three faceted sides, formed mainly by a mains facet extending deep from the girdle. The rib lines are bunched together in each corner, with four rib lines in each corner region. The facet lines in the pavilion are mostly located in the center near the culet, and this arrangement is obviously intended to be seen through the octagon table in the crown. The facets are either slivers (near the corner) or large main facets in the sides. The designer of this stone faceting arrangement intended to achieve a well balanced symmetrical stone having identical length sides and minimum faceting in the pavilion except for the center viewable through the rather small table.

Some of the main characteristic differences in these stones are summarized in the following table:

**Table**

**Rosenberg**

1. Profile: Two long sides, two short ends, four corners same as short ends
2. Crown equal steps
3. Large table percentage
4. Table has same shape as girdle
5. Pavilion sides and corners have many facets, no large main facet
6. No bunched multiple rib lines in corners

**Octo-Square Brilliant**

Cut-cornered with four equal sides

Crown unequal steps largest in middle, smallest on top

Small table percentage

Table has eight equal sides; Girdle has four sides and four shorter corners

Pavilion corners have only one facet; Pavilion sides have three facets, mostly one main facet

Four bunched rib lines in each corner

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Applicant urges that it would not have been obvious to modify the pavilion of the Rosenberg reference and substitute it with the pavilion of the Octo-Square Brilliant. The stones have different outlines and shapes, different step arrangements in the crown, different table percentages (the size of the table relative to the outline of the girdle), different pavilion arrangements (corner sliver and large side mains in Octo-Square Brilliant versus smaller mains spread around both the sides and corners throughout the pavilion in Rosenberg). The designers of these two respective stones clearly had designed unique faceting arrangements to achieve their intended purposes, and applicant urges that modifying their designs by choosing the Rosenberg crown and the Octo-Square pavilion is not suggested and would run contrary to their respective design schemes.

Applicant respectfully submits that the case of In re Seid cited by the Examiner for the general statement that "matters relating to ornamentation only, and having no mechanical function, cannot be relied on where claims are not directed to design but are structural claims," is not applicable to the presently claimed invention.

The invention at issue in the Seid case was an advertising display device in the form of an ordinary bottle for beverages together with a hollow member (representing a human figure from the waist up) which is adapted to fit over and cover the neck of the bottle. The claim at issue in that case recited the particular shape and arrangement of the upper part of the body of the hollow member. The CCPA held that those features "relate to ornamentation only and have no mechanical function what ever."

In the present case, the present claims recite a gemstone. As described in the specification, gemstones have characteristic features of brilliance (internal and external), dispersion and scintillation. The type of cut (brilliant, step or mixed) and the shape and arrangement of the facets determines the characteristic brilliance, dispersion and scintillation, because of how the incident light is reflected and other wise directed and broken up inside the gemstone.

The arrangements of facets, therefore, do more than merely provide an ornamental appearance on the exterior of the stone. This may be true if all light is ignored and the stone were represented

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by a solid material such as solid wood. However, because a gemstone's appearance includes how it will reflect and otherwise direct incident light, the facet arrangement performs a mechanical function. In this respect the claimed gemstone is not like the device claimed in the Seid case. In view of this significant and important distinction, applicant respectfully submits that the principle of the Seid case relied upon by the Examiner should not serve to treat the faceting arrangement as merely an ornamental exterior feature, because the faceting arrangement determines the mechanical properties of brilliance, dispersion and scintillation.

In view of the foregoing, applicant believes that the application is in condition for allowance, and such action is earnestly solicited.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in Communication with the filing of this Response. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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